IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

UNILOC USA, INC. AND UNILOC LUXEMBOURG S.A.,	§	
Plaintiffs,	§	**Civil Action No. 2:15-cv-578-RSP**
v.	§	
	§	**JURY TRIAL DEMANDED**
GENBAND US LLC,	§	
Defendant.	§	

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Defendant GENBAND US LLC ("GENBAND") hereby respectfully submits this responsive brief in support of its proposed constructions of the disputed terms of the asserted patents, U.S. Patent No. 7,804,948 ("the '948 Patent"), 7,853,000 ("the '000 Patent"), and 8,571,194 ("the '194 Patent") (collectively the "Patents-in-Suit").

I. INTRODUCTION

The Patents-in-Suit are directed to initiating conference calls using an instant messaging ("IM") system. A first user invites other users to join a real-time IM chat session. ('948 Patent, 3:36-37.) If the other users accept the IM chat session, then the participating users exchange text messages with each other in real-time through an IM service. (*Id*. at 3:37-41.) The first user may desire to initiate a conference call with the other participants of the IM chat session. (*Id*. at 3:51-55.) With a single action, the conference call requestor transmits a request to initiate a conference call from a network access device to a conference call server. (*Id*. at 3:63-66, 7:38-41, 12:7-10.) The conference call server, upon receiving the request, initiates the formation of a conference bridge between the conference call requester and the other participants of the IM chat session without input from the other participants. (*Id*. at 3:66-4:3, 12:13-17.)

The Patents-in-Suit are related to each other as continuations and share a common specification ("the Specification") and drawings. The '948 Patent was filed first and is the parent application to the '000 Patent and the grandparent to the '194' patent. For the sake of consistency and simplification, all references to the Specification in the remarks below are annotated with citations to column and line numbers in '948 Patent; however, identical support can be found in the other Patents-in-Suit and GENBAND relies on the corresponding portions of the specifications of those patents.

In order to reduce the number of disputed claim terms and to simplify the issues to be addressed in the claim construction hearing, GENBAND will not object to the constructions proposed by Uniloc for certain terms listed below. Additionally, after consideration of the arguments in Plaintiff's Opening Claim Construction Brief ("Pl. Opening Brief," Docket No. ("Dkt.") 45), GENBAND has clarified or provided alternate constructions for certain terms identified below.

Uniloc has alleged infringement of sixty-nine claims ("the Asserted Claims") in the Patents-in-Suit. (Pl. Opening Brief at 4.) This brief is organized so that the disputed terms appearing in the asserted independent claims (*i.e.,* claims 1, 23, and 51 of the '948 Patent, claims 1 and 23 of the '000 Patent, and claims 1, 6, 11, and 16 of the '194 Patent) are addressed first, followed by terms in the asserted dependent claims, and finally terms that do not appear in any Asserted Claims. Citations to the relevant portion of Uniloc's opening brief are provided for each disputed term to assist the Court in comparing arguments.

II. LEGAL STANDARDS

The Court is familiar with the principles of claim construction. Although the starting point for any claim construction analysis is the claim language and the patent itself, where the meaning of claim language is not readily apparent, courts may look to other sources to learn what a person of ordinary skill in the art would have understood the claim language to mean -- including the prosecution history and extrinsic evidence covering the relevant scientific principles, the meaning of technical terms, and the state of the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-14 (Fed. Cir. 2005). Reconciling the "twin axioms" of reading the claims in view of the specification and of not reading limitations from the specifications into the claims sometimes presents a difficult task. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904-05 (Fed. Cir. 2004).

If a particular feature serves the fundamental or overall purpose of the invention, it should be incorporated in the construction. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1324 (Fed. Cir. 2008). Further, "a claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention." *CCS Fitness, Inc. v. Brunswick Corp*., 288 F.3d 1359, 1366-67 (Fed. Cir. 2002). Moreover, the prosecution history, including the reexamination history, "demonstrate[s] how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it otherwise would be." *Phillips*, 415 F.3d at 1317.

Technical dictionaries and treatises may help to understand the underlying technology and the manner in which one skilled in the art might use claim terms. *Phillips*, 415 F.3d at 1318. Generally, extrinsic evidence is "less reliable than the patent and its prosecution history in determining how to read claim terms." *Id.*

III. TERMS WITH CONSTRUCTIONS ON WHICH THE PARTIES AGREE

Consistent with the parties' Joint Claim Construction Statement Pursuant to P.R. 4-3. (*See* Dkt. 41), the parties previously agreed upon the following constructions for terms appearing in the '948 and '000 Patents.

Terms and Phrases	Agreed Construction
voice over internet protocol '948 Patent: claims 6, 24 '000 Patent: claims 6, 15, 17, 20	the use of the Internet Protocol (IP) for transmitting voice communications[1]
wherein said application sharing capability is integrated with said instant messaging service '948 Patent: claims 11, 38, 54 '000 Patent: claim 11	an application sharing capability and an instant messaging service are combined into a functional unit

In order to reduce the number of disputed claim terms and to simplify the issues to be addressed at the claim construction hearing, GENBAND will not object to the constructions proposed by Uniloc for the following terms and will stipulate to Uniloc's proposed constructions for the purposes of this case.

Terms and Phrases	Agreed Construction
"instant messaging service" ('948 Patent: claims 1, 23, 51) ('000 Patent: claims 1, 23)	software that facilitates the exchange of instant messages between instant messaging clients
"a single request" "single step" "single requester indication" ('948 Patent: claim 1, 3, 8, 13, 51) ('000 Patent: claim 1, 23)	no construction necessary no construction necessary no construction necessary
"without requiring registration with a conference call server"	separate registration with a conference call server is not required to initiate voice

[1] GENBAND notes that the agreed construction for "voice over internet protocol" above is consistent with the parties' Joint Claim Construction Statement Pursuant to P.R. 4-3. (*See* Dkt. 41.) The construction listed in Uniloc's opening brief for this term appears to be included in error. (*See* Pl. Opening Brief at 4.)

'194 Patent: claims 1, 16	communication between current participants of an instant message session
"registration" '194 Patent: claims 1, 6, 11, 16	no construction necessary
"without requiring individual selection of and registration with a conference call server" '194 Patent: claims 6, 11	no construction necessary
"communicably connected to the IM session" '194 Patent: claims 1, 6, 11, 16	no construction necessary
"without requiring individual selection of potential members" '194 Patent: claims 1	no construction necessary
"IM presence" '194 Patent: claims 1	no construction necessary

IV. DISPUTED TERMS FOUND IN THE ASSERTED INDEPENDENT CLAIMS

A. "network [access/accessible] device"

(*See generally* Pl. Opening Brief at 5.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"network [access / accessible] device" '948 Patent: claims 1, 23, 51 '000 Patent: claims 1, 23	any device capable of communicating over a network to one or more other Network Access Devices using a common protocol. Such NADs can include but are not limited to computers, servers, workstations, Internet appliances, terminals, hosts,	any device capable of communicating over a network to one or more other Network Access Devices using a common protocol.

	personal digital assistants ("PDAs"), and digital cellular telephones.	

As noted in Plaintiff's Opening Claim Construction Brief, the inventor of the Patents-in-Suit has acted as his own lexicographer by expressly defining terms used in the Specification. The term "Network Access Device" or "NAD" has been defined by the inventor as a particular type of device. (*See* '948 Patent, 5:39-41.) The inventor has also included a list of example devices that may meet the definition of "Network Access Device." (*See* '948 Patent 5:42-45.) Uniloc improperly seeks to include the list of example devices as part of the definition of the term "Network Access Device." "It is a fundamental logical principle that an example is not a definition (unless the example is the only thing capable of satisfying the terms of the definition)." *Todd Pacific Shipyards Corp. v. Director, Office of Workers' Compensation Programs,* 913 F.2d 1426, 1430 n.3 (9th Cir. 1990). The construction of "Network Access Device" should be limited to the clear definition set forth by the inventor.

Furthermore, it is worth noting that the listed example devices are themselves Network Access Device only to the extent that they satisfy the definition provided by the inventor – *i.e.*, a PDA is a Network Access Device only if it is "capable of communicating over a network to one or more other Network Access Devices using a common protocol." Therefore, the inclusion of the list of examples is not helpful and is confusing to the extent that a particular device could be misidentified as a Network Access Device – even if it does not meet the express definition provided by the inventor – simply because the device type is on the example list. The Court should construe this term as defined by the inventor and not include the unhelpful and potentially misleading list of example devices.

B. "conference call server"

(*See generally* Pl. Opening Brief at 10.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"conference call server" '948 Patent: claims 1, 23, 51 '000 Patent: claims 1, 23 '194 Patent: claims 1, 6, 11, 16	computer or program that facilities the establishment of the conference call	server that initiates a conference call

Consistent with GENBAND's proposed construction, the Specification consistently describes the "conference call server" as initiating or requesting initiation of a conference call bridge. ('948 Patent, 6:34-35, 6:57-59, 8:11-12.) Uniloc objects to GENBAND's proposed construction as excluding certain preferred embodiments, such as where the conference call server may use third party conference call providers. (*See* Pl. Opening Brief at 10 (citing '948 Patent, 8:25-28.)) GENBAND's proposed construction does not exclude the use of third party conference call providers and, therefore, does not conflict with the cited embodiments. The Specification makes clear that whenever a third party conference call provider is involved, the third party conference call provider is used by conference call server. (*See* '948 Patent, 8:25-28, "The conference call server may further utilize third party conference call providers for the actual initiation of a conference call based on parameters generated by the conference call server or the conference call requester." *See also id.* at 11:10-13, 11:34-40.)

Uniloc's proposed construction improperly expands the term "server" into "a computer or program" using extrinsic evidence. There is no need to look beyond the intrinsic evidence of the

Specification to construe the term "conference call server." According to Uniloc's proposed construction, the "conference call server" may be a program in and of itself. This extremely broad construction would encompass programs or software that is not even running on a computer. Such a construction is in conflict with the Specification and the Asserted Claims, which require that the "conference call server" initiate or request initiation of a conference call and, therefore, require that a server is actually executing some type of conference call software. (*E.g.* '948 Patent, 6:34-35.)

The construction proposed by GENBAND is consistent with the preferred embodiments and is supported by the intrinsic evidence. Accordingly, GENBAND's proposed construction should be adopted by the Court.

C. "instant messaging . . ."

(*See generally* Pl. Opening Brief at 16.)

The term "instant messaging" is relevant to several other disputed claim terms ("instant messaging service," "instant messaging [IM] session," "communicably connected to the IM session," and "IM presence") and to some undisputed claim terms ("instant messaging software" ('948 Patent, Claim 51) and "instant messaging (IM) chat window" ('194 Patent, Claim 1)). Accordingly, "instant messaging" is a key aspect of the Asserted Claims and must be properly construed. Once the proper construction for the term "instant messaging" is determined, then the particular type of service, session, software, or chat window required in the Asserted Claims can be properly construed.

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"instant messaging . . ." '948 Patent: claims 1, 23, 51 '000 Patent: claims 1, 23 '194 Patent: claims 1, 6, 11, 16	no construction necessary if construed at all, "instant messaging . . ." should be construed in the context of the broader phrase in which it appears, as in "instant messaging service"	communicating in real time with other users by exchanging messages in online chat areas and receiving alerts when other users are online

The term "instant messaging" is used in the Asserted Claims to identify a particular type of service, session, software, or chat window. The Patents-in-Suit are directed to "initiating conference calls via an *instant messaging [IM]* system to reduce the effort required to initiate and manage the call." ('948 Patent, Abstract (emphasis added).)

According to the inventor, "instant messaging" is a form of real-time or on-line collaboration. (*Id.* at 1:30-32, "There are various forms of real-time, or on-line, collaboration. The simplest form is instant messaging.") The Specification further describes how instant messaging works:

> Instant messaging (hereafter "IM") systems employ a client-server model on Internet protocol (hereafter "IP") networks to deliver text chat and other information to distributed users in *real-time*. Instant Messaging client software may be loaded onto a user's workstation or may be used in a web browser, and may allow a user to log into a remote Instant Messaging server. Once a user has logged in, business rules may be used to determine which other users are available to communicate with the first user in the instant messaging system. Many IM systems allow users to create lists of other users that they commonly communicate with. When a user in such a list logs into the IM system, the server informs the list owner that a user in their list has logged on and is available to chat. . . . Once a user has the address of a second

> user, the first user can request a collaborative *chat session* with the second user. The second user can choose to either accept or reject the *chat session*. After the session has been accepted, the users may be able to communicate in a private or public chat session by typing text messages to one another. The message can be either transmitted through a central server, or directly between users (peer to peer) once the first user has determined the availability of the second user from the IM system. . . .

(*Id*. at 3:45 (emphasis added).) The Specification's description of instant messaging is not restricted only to certain embodiments or to certain use cases of that term. Instead, the above-quoted disclosure clearly describes what was meant by all uses of "instant messaging' at the time of the invention and how that term is understood as applied to the Asserted Claims. Claims are interpreted to cover no more than what the Specification supported at the time of filing. *Schering Corp. v Amgen Inc*., 222 F.3d 1347, 1353 (Fed. Cir. 2000).

The extrinsic evidence also supports both the inventor's description of "instant messaging" and GENBAND's construction. For example, a relevant and well-known technical dictionary defined "instant messaging," in part, as a "service that alerts users when friends or colleagues are on line and allows them to communicate with each other in real time through private online chat areas. With instant messaging, a user creates a list of other users with whom he or she wishes to communicate; when a user from his or her list is on line, the service alerts the user and enables immediate contact with the other user." See Exhibit 1, Microsoft Computer Dictionary, Fifth Edition (2002) at 276.

Instant messaging should be construed as distinct from other forms of messaging or communication. Furthermore, because technical terms evolve over time and users become exposed to and grow more comfortable with new technology, such as different types of text messaging, it is important to define what the inventor intended by term "instant messaging" in the context of Asserted Patents.

GENBAND's proposed construction is consistent with both the intrinsic and extrinsic evidence. "Instant messaging" is a particular form of communication that takes place in real time with other users by exchanging messages in online chat areas and it allows a user to receive alerts when other users are online or available for a chat session.

D. "instant messaging [IM] session"

(*See generally* Pl. Opening Brief at 14.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"instant messaging [IM] session" '948 Patent: claims 1, 23, 51 '000 Patent: claims 1, 23 '194 Patent: claims 1, 6, 11, 16	no construction necessary	a period of time between an initiation of a connection to an instant messaging service and a termination of the connection to the instant messaging service during which participants maintain the connection in order to bidirectionally exchange instant messaging messages in real time - or - a real-time connection between users for some duration that starts when a user accepts a request to join the session, during which instant messages are exchanged between the users

GENBAND has provided an alternative construction of the term "instant messaging [IM] session" in view of the proposed construction of "instant messaging" above. Once the term "instant messaging" is properly construed as discussed above, the only issue remaining for this term is to understand what a "session" is in the context of "instant messaging."

The Specification teaches that a first user may request a "chat session" with a second user on an instant messaging system. ('948 Patent, 3:36-37.) If the second user accepts the chat session, the users may communicate in the chat session by typing messages to one another. (*Id.* at 3:9-41.) The chat session described in the Specification corresponds to the "instant messaging session" required in each of the independent claims.

Uniloc objected to GENBAND's original proposed construction because it included a "period of time." *See* Pl. Opening Brief at 15. GENBAND has revised its proposed construction to clarify that a "session" lasts for "some duration," which is consistent with the concept of session disclosed in the Specification. GENBAND's proposed construction does not attempt to set a specific period of time, but instead merely indicates that a session has some beginning and some end that can be determined based upon when a second user agrees to join the session and leaves the session. This is completely consistent with the description provided in the patent of how a session is initiated, as described above.

GENBAND's proposed construction is consistent with, and in fact reinforced by, the use of "instant messaging [IM] session" in the Asserted Claims. All of the Asserted Claims in the '948 Patent and the '000 Patent require "a plurality of potential targets . . . participating in a given instant messaging session." All of the Asserted Claims in the '194 Patent require that "at least one other party is communicably connected to the IM session." The requirements of "participating in" and being "communicably connected to" the instant messaging session are consistent with the requirement that the "session" must last for a certain period of time or for some duration. Clearly, the potential targets cannot be "participating in" and being "communicably connected to" the instant messaging session for an unlimited period.

Also, GENBAND's proposed construction of "session" is consistent with extrinsic evidence. For example, a relevant and well-known technical dictionary defined "session," in a communications context, as "the time during which two computers maintain a connection." See Exhibit 1, Microsoft Computer Dictionary, Fifth Edition (2002) at 475.

Furthermore, an industry standards document that is contemporaneous with the filing of the '948 Patents and its parent provisional application, makes clear that at the time of filing the Patents-in-Suit, an "instant messaging session" was understood by those of ordinary skill in the art to be different from other "instant messaging" models. (*See* Exhibit 2, Campbell, B., et al., "Session Initiation Protocol (SIP) Extension for Instant Messaging", (December 2002) at 3.) An instant messaging "session" is "an explicit conversation with a clear beginning and end." (*Id.*) This "session" model is contrasted with a "MESSAGE" method that is employed by two-way pagers or SMS-enabled handsets (*i.e.*, "texting"). (*Id.*) In the MESSAGE method for sending instant messages "there is no explicit association between messages. Each IM stands alone --any sense of a 'conversation' only exists in the client user interface, or perhaps in the user's own imagination." (*Id.*)

GENBAND's proposed construction is consistent with the meaning of "instant messaging session" as understood by those of ordinary skill in the art and, therefore, this construction should be adopted by the Court.

V. INDEFINITE CLAIM TERMS IN THE INDEPENDENT CLAIMS

Patent claims must "particularly point [ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 ¶ 2 (2006). A lack of definiteness as required by the second paragraph of Section 112 renders the patent or any claim in suit invalid. 35 U.S.C. § 282(b)(3)(A). In *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Supreme Court held that under 35 U.S.C. § 112 ¶ 2, "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." 572 U.S. ____, 134 S. Ct. 2120, 2124 (2014). The Supreme Court found it insufficient "that a court [could] ascribe some meaning to a patent's claims." *Id.* at 2130. On remand, the Federal Circuit explained that "[t]he definiteness standard must allow for a modicum of uncertainty to provide incentives for innovation, but must also require clear notice of what is claimed, thereby appris[ing] the public of what is still open to them." *Interval Licensing LLC v. AOL*, 766 F.3d 1364, 1370 (Fed. Cir. 2014) (internal quotations marks removed) (quoting *Nautilus*, 134 S.Ct. at 2128–29).

The terms of the asserted claims addressed below are indefinite because the Patents-in-Suit do not inform those skilled in the art about the scope of the invention with reasonable certainty.

A. "automatically"

(*See generally* Pl. Opening Brief at 18 and 21.)

The word "automatically" occurs in a number of disputed terms. The Specification does not use the term "automatically," and does not describe how "a conference call connection" may be "automatically" established. The plain meaning of word "automatically" indicates that some action is being taken spontaneously without requiring further input. In the context of the disputed terms, it is unclear what entity is acting spontaneously and what further input is not required.

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"automatically establishing a conference call connection to said conference call requester" '948 Patent: claim 1	no construction necessary	indefinite - or - a conference call is established with no input from the potential targets[2]
"automatically initiating a conference call" '948 Patent: claim 23	no construction necessary	indefinite - or - a conference call is initiated with no input from the potential targets[3]
"a conference call connection . . . is automatically established" '000 Patent: claim 1, 23	no construction necessary	indefinite - or - a conference call connection is established with no input from the potential targets[3]
"automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members" '194 Patent: claim 1, 6, 11[3]	no construction necessary	indefinite - or - voice communication is initiated with no input from the current participants of the IM session and without requiring individual selection of potential members[3]

[2] GENBAND has proposed an alternative construction should the Court find that the disputed terms are not indefinite.

[3] It appears that Asserted Claims 6 and 11 of the '194 Patent were inadvertently not listed in Joint Claim Construction Chart. The term should be construed the same way for each of Asserted Claims 1, 6 and 11.

The term "automatically" was not included in the originally filed claims of the '948 Patent, but was added in an Amendment (*See* Exhibit 3, September 3, 2009 Amendment at 2, 6, 10.) The Amendment was filed in response to a rejection that cited the Haims publication as anticipating then pending claim 1. (*See* Exhibit 4, March 5, 2009 Office Action at 4 (citing Exhibit 5, U.S. Patent Publication No. 2003/0105820A1 to Haims et al. ("*Haims*")).)

The March 5, 2009 Office Action cited paragraphs [0111]-[0114] of *Haims* as anticipating the pending claim 1. *Haims* teaches an inviting user can determine if invited users are available by updating their presence information on a contact list. (Haims at ¶[0111].) The inviting user sends an invitation to the invited users through a messaging server. (*Id.* at ¶[0112].) The invited users may accept or decline the invitation. (*Id.* at ¶[0113].) Conferencing services are then initiated between the inviting users and the invited users who have accepted the invitation. (*Id.* at ¶[0114].)

In response to this rejection, the applicant amended the relevant term in claim 1 to read:

> **automatically** establishing a conference call connection to said conference call requester, said conference call connection initiated by said conference call server, said conference call connection further being connected to ~~at least a other target~~ **each of the potential targets**.

(*See* Exhibit 3, September 3, 2009 Amendment at 2.) The applicant distinguished the amended claims over the *Haims* publication with the following argument:

> [] Haims proposes that a user determine whether attendees are available and select ones for invitation. . . . In contrast, Claim 1 calls for the system to automatically establish a conference call with a plurality of users who are then participating in a common IM session with the requester responsively to a single requester request.

(*See* Exhibit 3, September 3, 2009 Amendment at 14.) Claim 1 as amended was then allowed by the Examiner and issued as Asserted Claim 1 of the '948 Patent.

Applicant distinguished amended pending claim 1 over the *Haims* as not requiring interaction with the potential targets. According to applicant's argument in the '194 Patent file history, the addition of the word "automatically" means that the method of Claim 1 of the '194 Patent does not need to send an invitation to invited users and that the invited users do not have the opportunity to accept or decline the conference call connection. Instead, based upon the addition of the word "automatically," the conference call requestor can join potential targets into a conference call connection without sending an invitation to the potential targets and without requiring a potential to accept or decline the conference call. The Specification does not disclose whether potential targets can avoid being joined into a conference call or how such a call would be avoided by the potential target. The Asserted Claims do not clarify whether any input from the potential targets is required or even accepted before being joined to a conference call.

Accordingly, the Asserted Claims fail to inform those skilled in the art about the scope of the invention with reasonable certainty and, therefore, the Asserted Claims 1 and 23 of the '948 Patent are indefinite. Alternatively, if not indefinite, these claims should be construed to interpret the term "automatically" to mean that a conference call is established with no input from the potential targets.

Asserted Claim 23 of the '948 Patent was allowed in a similar manner as Claim 1. Asserted Claims 1 and 23 of the '000 Patent included the term "automatically" from the initial filing date of that patent and were allowed without amendment. Asserted Claims 1, 6, and 11 of the '194 Patent included the term "automatically" from their initial introduction in the prosecution history and were allowed without further clarification of this term. These Asserted Claims are subject to the same interpretation as Asserted Claim 1 of the '948 Patent.

B. "those of the at least one other party"

(*See generally* Pl. Opening Brief at 21.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"those of the at least one other party" '194 Patent: claims 1, 6, 11, 16	no construction necessary	indefinite

During prosecution of the '194 Patent, the original pending claims were replaced by pending claims 80-102 in a Preliminary Amendment that was filed with the original application. In response to an Office Action, claims 80-102 were replaced by new pending claims 103-118. (*See* Exhibit 6, June 24, 2011 Response at 2-6.) New independent claims 103, 108, 113, and 118 included the limitation:

> wherein after determining the at least one party, the voice communication is established between the first party and those of the at least one other party who agreed to enter into the voice communication.

(*Id.*) After the Examiner rejected pending claims 103-118 in a Final Office Action, the applicant amended the pending independent claims to include the following change:

> wherein after determining the at least one party, the voice communication is established between the first party and those of the at least one other party ~~**who agreed to enter into the voice communication**~~.

(*See* Exhibit 7, July 9, 2012 Amendment After Final Rejection at 3-7.) The applicant included no remarks directed to this amendment, but instead argued that a separate amendment distinguished the pending claims over the Final Office Action rejection. The amendment shown above is consistent with the prior analysis for the term "automatically." The applicant's deletion here supports the requirement that the "other party" does not have the choice whether to accept or decline the conference call connection.

Pending claims 103, 108, 113, and 118 were allowed following subsequent amendments that added additional elements, but no further remarks were directed to the amendment quoted above. Allowed pending claims 103, 108, 113, and 118 were renumbered and issued as Asserted Claims 1, 6, 11, and 16 of the '194 Patent.

On its face, the above-quoted limitation appears to require that "the voice communication is established between" two endpoints; however, when read closer, this limitation is nonsensical. The two endpoints to the "voice communication" are (1) "the first party" and (2) "those of the at least one other party." The obvious question is: "those" what? Neither the text of the Asserted Claims nor the Specification provides an answer.

Claim terms cannot be rewritten by the court to save their validity. *Hill-Rom Services, Inc., et al. v. Stryker Corp. et al.*, 755 F.3d 1368, 1374 (Fed. Cir. 2014). It would be inappropriate to ignore the plain language of the claims, including the term "those" in the limitation "those of the at least one other party," or to read in some other language.

Asserted Claims 1, 6, 11, and 16 of the '194 Patent fail to inform those skilled in the art about the scope of the invention with reasonable certainty. The term "those of the at least one other party" is indefinite and does not provide clear notice of what is claimed.

C. "A non-transitory computer readable medium . . . the following steps"

(*See generally* Pl. Opening Brief at 21.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"A non-transitory computer readable medium . . . the following steps" '194 Patent: claims 1, 6, 11, 16	no construction necessary	indefinite

Pending claims 103-118 were added to the '194 Patent after the application was filed. (*See* Exhibit 6, June 24, 2011 Response at 2-6.) Once allowed, pending claims 103, 108, 113, and 118 were renumbered and issued as Asserted Claims 1, 6, 11, and 16 of the '194 Patent.

The Specification, which dates back to an original filing date in December 2004, does not use the terms "non-transitory computer readable medium" together or individually – other than the use of "computer" alone. The term "non-transitory computer readable medium containing computer instructions" was introduced into the patent over six years after the priority date. The Specification provides no indication of what constitutes a "non-transitory computer readable medium" and provides no indication of what the limitation "non-transitory" means. While the Specification uses the term "software," which may correspond to the "computer instructions," there is no disclosure of a "medium" containing software. Figure 12B includes box 1206, which is labeled "conference setup software," but provides no further indication of what that box represents or how such software is stored or contained in a "non-transitory" manner.

Asserted Claims 1, 6, 11, and 16 of the '194 Patent fail to inform those skilled in the art about the scope of the invention with reasonable certainty. The term "non-transitory computer readable medium" is indefinite and does not provide clear notice of what is claimed. As an accused infringer, GENBAND has no way to know what the scope of "computer readable medium" includes and whether such media might be considered "non-transitory."

VI. DISPUTED TERMS FOUND ONLY IN ASSERTED DEPENDENT CLAIMS

A. "conference bridge"

(*See generally* Pl. Opening Brief at 6.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"conference bridge" '948 Patent: claims 5, 13-14, 16, 41, 43, 44, 46, 58-59, 61 '000 Patent: claims 13-14, 16	switching circuitry (software, hardware, or combinations thereof) used to interconnect two or more communications paths connected to participants to allow simultaneous conversations between the participants	switching circuitry used to interconnect two or more communications paths connected to participants to allow simultaneous conversations between the participants

In construing a claim term, the Court should look at the term's plain meaning unless the patentee sets out a definition and acts as his own lexicographer. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 723 F.3d 1363, 1373 (Fed. Cir. 2013). "Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change." *In re Paulsen,* 30 F.3d 1475, 1480 (Fed. Cir. 1994) (internal quotation marks omitted).

The inventor of the Patents-in-Suit has acted as his own lexicographer and set out a definition of the term "conference bridge." (See '948 Patent, 5:61-64.) Uniloc improperly seeks to modify the inventor's definition. It would be clear to one of ordinary skill that the plain meaning of "circuitry" includes hardware and not software. By explicitly defining the term "conference bridge" to be "switching circuitry," the inventor has excluded conference bridges that exist as pure software. The examples cited by Uniloc do not support a construction in which the conference bridge is software. Instead, as noted by Uniloc, the conference bridge may *involve* software. (Pl. Opening Brief at 6.)

Moreover, the term "switching circuitry" is not used in the Asserted Claims and, therefore, does not need to be construed.

B. "publicly switched telephone network"

(*See generally* Pl. Opening Brief at 7.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"publicly switched telephone network" '948 Patent: claims 5, 25 '000 Patent: claim 5	voice networks and related services	no construction necessary

The term "publicly switched telephone network," which is abbreviated as "PSTN," is well known to those of skill in the art and does not require construction. The Specification notes that "[t]he voice networks are referred to as a publicly switched telephone network (PSTN) and its related services." ('948 Patent, 6:4-5.) At best, this is a definition for "voice networks" not for "publicly switched telephone network." Uniloc's proposed construction mixes up the terms in this definition. Uniloc's proposed construction incorrectly implies that the term "publicly switched telephone network" encompasses all voice networks. The Specification distinguishes the PSTN as a telephone network that is separate from VOIP, cellular, and satellite networks.

(*See* '948 Patent, element 408 of Figure 4, and 2:61-63, 4:14-15.) The term "publicly switched telephone network" does not require further construction.

C. "application sharing capability"

(*See generally* Pl. Opening Brief at 8.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"application sharing capability" '948 Patent: claims 9-11, 36-38, 52-54 '000 Patent: claims 9-11	the ability of two or more devices to access a single application	no construction necessary

The meaning of the term "application sharing capability" is clear on its face and this term needs no further construction. This term should be given its plain and ordinary meaning to one of skill in the art.

Uniloc's proposed construction is not only unnecessary but is also inconsistent with the language of the Asserted Claims. For example, Claim 9 of the '948 Patent requires that a "network access device further comprises an application sharing capability." Uniloc's proposed construction conflicts with this limitation. If Uniloc's proposed construction is adopted, then Claim 9 of the '948 Patent would be interpreted to mean that a "network access device further comprises [the ability of two or more devices to access a single application]." It is nonsensical for a single network access device to comprise the ability for multiple device to share an application. The Specification does not disclose a single device that has the abilities of multiple devices.

Uniloc's proposed construction should be rejected since the plain meaning of the term "application sharing capability" is sufficient to understand the claims that use include this limitation.

D. "cellular communications path"

(*See generally* Pl. Opening Brief at 12.)

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"cellular communications path" '948 Patent: claims 8, 29 '000 Patent: claim 8	a communications path that at least partially utilizes a cellular communications network	no construction necessary

The term "cellular communications path" is clear on its face and no further construction is needed. This term should be given its plain and ordinary meaning to one of skill in the art.

The Specification discloses a number of different "paths," including voice over Internet protocol (VOIP) paths ('198 Patent, 5:56-57, 6:15), communication paths (*id.* at 6:63), cellular paths (*id.* at 8:61), satellite paths (*id.*), and network paths (*id.* at 10:64). Uniloc's proposed construction improperly attempts to broaden the term by expanding the claimed "cellular communications path" to a generic "communications path" that only "utilizes a cellular communications network." Such a construction would improperly read in all of other types of "paths" disclosed in the Specification into the term "cellular communications path."

This term should be given its plain meaning and Uniloc's proposed construction should be rejected.

E. "wherein the step of initiating a conference call comprises communicating information from said conference call server establishes a conference bridge between said call requester and at least one target"

This term was included in the parties' Joint Claim Construction Chart. (*See* Exhibit A to the Joint Claim Construction Statement Pursuant to P.R. 4-3 at 6 (Dkt. 41-1).) However, it was not addressed by Uniloc in Plaintiff's Opening Claim Construction Brief.

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"wherein the step of initiating a conference call comprises communicating information from said conference call server establishes a conference bridge between said call requester and at least one target" '948 Patent: claim 43	no construction necessary alternatively, "wherein the step of initiating a conference call comprises communicating information from said conference call server that establishes a conference bridge between said call requester and at least one target"	indefinite

This term is indefinite because when read as a whole it is nonsensical and, therefore, fails to inform those skilled in the art about the scope of the invention with reasonable certainty. In particular, the use of the word "establishes" is confusing and does not make sense in this context. This term appeared in its present form as the originally filed Claim 43 of the '948 Patent, and the term was not further amended during prosecution. It may be that the inventor intended to use another word or another form of the word "establishes" in this term. However, the claim cannot now be corrected to insert another word in place of "establishes" or to otherwise rewrite this limitation. "Claim terms . . . cannot be rewritten by the courts to save their validity." *Hill-Rom Services, Inc.* 755 F.3d at 1374. Accordingly, the Court should find this term to be indefinite.

VII. DISPUTED TERMS NOT FOUND IN ASSERTED CLAIMS

Uniloc alleges that GENBAND infringes or has infringed sixty-nine claims from the Patents-in-Suit. (*See* Pl. Opening Brief at 4.) As noted above, GENBAND and Uniloc disagree on the proper construction of a number of the Asserted Claims. Uniloc further demands that the Court construe several terms ("the Unasserted Terms") that are not found in any of the Asserted Claims. (*See* Pl. Opening Brief at 9 and 17.) Uniloc alleges that construction of these Unasserted Terms, which are spread across fourteen unasserted dependent claims, would be of little burden to the Court. (*See* Pl. Opening Brief at 9.)

The Unasserted Terms are set forth in the following chart.

Terms and Phrases	Uniloc's Proposed Construction	GENBAND's Proposed Construction
"addresses" '948 Patent: claims 17, 47, 63 '000 Patent: claims 18-20	identifiers where a participant to a conference call may be contacted, and may be, but is not limited to, a PSTN or cellular phone number, such as an ANI, or a unique identifier associated with a voice over Internet protocol communications path	not in asserted claims
"automatic number identifier" '948 Patent: claim 19 '000 Patent: claim 19	a direct phone number of a call participant, and is typically the number at which a person may be directly dialed	not in asserted claims
"third party conference call service" '948 Patent: claims 13, 41-42, 58, 61 '000 Patent: claim 13	a third party that provides a conference call server	not in asserted claims

Unless Uniloc amends its Invalidity Contentions to assert claims that include the Unasserted Terms, neither party has any reason to address these claims at trial. Given that there are already sixty-nine claims current at issue, it is extremely unlikely that Uniloc would assert an additional fourteen dependent claims. More likely, Uniloc will reduce the current set of Asserted Claims to a more manageable number for trial.

Until Uniloc asserts the dependent claims in which the Unasserted Terms are found, there is no controversy between Uniloc and GENBAND regarding these terms. An order setting forth a construction of these terms would be an impermissible advisory opinion. *See, e.g.*, *Jang v. Bos. Sci. Corp.*, 532 F.3d 1330, 1336 (Fed. Cir. 2008) (explaining that "Article III does not permit the courts to resolve issues when it is not clear that the resolution of the question will resolve a concrete controversy between interested parties.") Accordingly, the Court should not provide an advisory construction of the Unasserted Terms.

GENBAND would be highly prejudiced if it had to provide proposed constructions for these terms at this time without knowledge of potential disputes that might arise later with respect to infringement and/or invalidity. For example, given that there are no infringement allegations and no accompanying claim charts involving these claim terms and phrases, GENBAND does not know how Uniloc might asserting these terms and phrases for infringement. Moreover, GENBAND has not had an opportunity to search for invalidating art for the claims that include these Unasserted Terms given that the unasserted claims were not identified in Uniloc's infringement contentions. GENBAND believes that asking the Court and parties to expend additional resources construing terms in claims that are not asserted is unnecessary and unduly burdensome.

Uniloc is actively involved in three Eastern District of Texas cases alleging infringement of the Patents-in-Suit against other defendants. If the Unasserted Terms are relevant to infringement claims in those other cases, then Uniloc can seek the appropriate construction there.

VIII. CONCLUSION

For the foregoing reasons, Defendant GENBAND US LLC respectfully requests that the Court construe the disputed terms in accordance with GENBAND's proposed constructions.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of this document has been served on all counsel of record via electronic mail through Local Rule CV-5(a) on this 11th day of February, 2016.

/s/ Michael J. Fogarty, III
Michael J. Fogarty, III